

REMARKS

Claims 16-40 are pending in the present application. Claims 16-28 have been amended to correct informalities and to further clarify and define the invention. Claims 29-40 have been added. Support for the claim amendments can be found in the specification, inter alia, at page 6, line 3 – page 7, line , and Fig. 3. Support for the new claims can be found in the original claims and in Fig. 1. Accordingly, applicants respectfully submit that no new matter has been added. Based on the above amendments and following remarks, applicants respectfully request reconsideration of all outstanding rejections.

Objections to the Specification and Drawings

The title has been amended in response to the Examiner's comments in item no. 4, page 2 of the Office Action dated June 22, 2000.

An Abstract has been added in response to the comments in item no. 3, page 2 of the Office Action. An Abstract on a separate sheet is attached herewith for Examiner's convenience.

The drawings have been amended in response to the comments in item no. 2, page 2 of the Office Action. In particular, proposed Fig. 4 shows a prism (2a) for avoiding the rotation of the object to be measured. Support for the new Figure 4 can be found in the original specification at page 2, lines 11-16, and Fig. 1. Regarding the comments concerning the Dove prism and the Abbe prism, applicants respectfully submit that Fig. 4 is a sufficient illustration of such a prism. A person of ordinary skill in the art knows the detailed configuration of an Abbe or Dove prism. Thus, applicants respectfully submit that separate detailed drawings of both an Abbe and a Dove prism are not necessary. Concerning the comments regarding the previously claimed "adjusting device" feature, that feature has been deleted from the claims.

The specification has been amended to correct informalities and to add language concerning new Fig. 4. Support for the amendments to the specification can be found in Fig. 1 and the original claims. Applicants respectfully submit that no new matter has been added.

Rejections Under 35 U.S.C. § 112, second paragraph

In the Office Action dated June 22, 2000, the Examiner rejected claims 16, 23-25 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claims 16 and 23-25 to provide proper antecedent bases and to clarify the features recited therein.

In addition, claim 23 has been amended to remove the offending recitation concerning the placement of the optical system for image rotation. Claim 16, from which claim 23 depends, recites "the optical system is disposed between a scanning lens and a scanning mirror of a laser scanner." Claim 23 now recites: "the optical system for image rotation is disposed after the ocular."

Based on the above amendments, applicants respectfully request reconsideration of the rejections based on 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 16-18 and 20-27 under 35 U.S.C. § 103(a) as being unpatentable over Dixon et al. (US 5,760,951) in view of Dewald et al. (US 5,365,288). Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dixon et al./Dewald et al. in further view of Wasmund et al. (US 4,181,436). Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dixon et al./Dewald et al. in further view of Kapitza (US 5,896,224). Applicants respectfully traverse these rejections for the reasons stated below.

The Dixon et al./Dewald et al. combination does not teach or suggest each element recited in independent claims 16 and 29. Neither Dixon et al. nor Dewald et al. teaches or suggests a "microscope." The term "microscope" is recited in the body of claims 16 and 29 and is meant to breathe life and meaning into the claim. Contrary to the interpretation proffered in the Office Action on page 4, - Dixon et al. discloses a confocal scanning system

for macroscopic samples (see Abstract: line 2). Dewald et al. also fails to teach or suggest a microscope.

Futhermore, the system described by Dixon et al. does not teach or suggest the following recited features: an "ocular," a "tube lens" or an "optical system ... disposed between a scanning lens and a scanning mirror" (claim 16); and an "ocular," a "tube lens" or an "optical system ... disposed between the tube lens and objective" (claim 29).

In addition, applicants respectfully submit that Dixon et al. teaches away from microscopes and microscopic applications. The confocal scanning system shown in Dixon et al. Fig. 2 is designed for imaging macroscopic samples (see Dixon et al., col. 2, lines 8-10: "The invention described in this application relates primarily to the imaging of macroscopic samples.").

Dewald et al. fails to overcome the deficiencies of Dixon et al because Dewald et al. fails to teach or suggest a "microscope," an "ocular" or a "tube lens." While Dewald et al. teaches a K-mirror assembly for image rotation (see Dewald et al. Fig. 2), nevertheless, the Dewald disclosure does not teach a skilled person to apply the disclosed optical system to a microscope or a confocal microscope. The Dewald invention relates to light projectors (see col. 1, lines 9-10).

If a person of ordinary skill in the art combined Dixon et al. and Dewald et al., the result would not be a microscope or confocal microscope having the structure as claimed. Thus, the principle of operation of the proposed Dixon et al./Dewald et al. combination would need to be substantially reconstructed in order to render the claimed invention obvious. Such a reconstruction would change the principle of operation of both Dixon et al. and Dewald et al., and is not permitted according to M.P.E.P. 2143.01.

Furthermore, because there is no suggestion in the Dewald et al./Dixon et al. combination for a microscope, applicants respectfully submit that there is insufficient motivation to combine Dewald et al./Dixon et al. with Wasmund et al. or Kapitza. No motivation for a skilled person can be derived from Dixon alone or in combination with Dewald to arrive at the subject matter presently claimed in claim 16 and claim 29. Accordingly, for at least the reasons mentioned above, applicants respectfully submit that

claims 16 and 29 are patentable over the references of record. In addition, dependent claims 17-28 and 30-40 are also patentable for at least the reasons mentioned above.

Conclusion

If applicants have not accounted for any fees required by this Amendment, the Commissioner is hereby authorized to charge to our Deposit Account No. 19-0741. If applicants have not accounted for a required extension of time under 37 C.F.R. § 1.136, that extension is requested and the corresponding fee should be charged to our Deposit Account.

The Examiner should feel free to contact the undersigned at (202) 672-5592, if there is anything the undersigned can do to assist the Examiner or expedite prosecution of the application.

Respectfully submitted,

Date

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By

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